REMARKS/ARGUMENTS

Claims 1-21 were pending in this application, of which claims 1-11 have been withdrawn from consideration as being drawn to a non-elected invention. Claim 17 has been amended by way of the present amendment, Claim 1-11 have been canceled without prejudice or disclaimer, and no new claims have been added. Support for the amendments may be found throughout the original specification and figures. As such, it is submitted that no new matters enter by way of the present amendment. Hence, claims 12-21 remain pending and under consideration. Entry of the amendment and reconsideration of the subject application as amended is respectfully requested.

Election/Restriction

The finality of the election/restriction requirement is acknowledged, with the subject matter of claims 1-11 withdrawn from consideration as being directed to a non-elected invention and reserved for a divisional application.

Allowable Subject Matter

The allowability of claims 12-16 is hereby acknowledged with appreciation.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,975,514 to Emigh et al. (hereinafter "Emigh"), in view of U.S. Patent No. 1,109,127 to Juengst (hereinafter "Juengst"). This rejection is respectfully traversed for at least the reasons which follow.

The present claims are directed to a method for selecting inserts for insertion wherein, upon closing the gripping jaw and grasping at least one insert between the first opposing member and the second opposing member of the gripping jaw, the extensible joint adjusts itself to vary a distance between the upper portion and the lower portion of the bar as the

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gripping jaw closes. This adjustment of the extensible joint varies the distance from the upper portion to the lower portion of the bar such that the distance at the extensible joint is proportional to the thickness of the insert(s).

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on Applicants' disclosure. *See M.P.E.P.* §§ 2143.01 and 2143.03.

Initially, Applicants submit that one of skill would not be led to combine the teachings of Juengst and Emigh. To incorporate the non-automated, mechanical apparatus of Juengst into the automated design of Emigh would require significant rearrangement of the Emigh apparatus as well as manual operation. Any possible final outcome would be highly unpredictable and counter-intuitive to the automated purpose of the Emigh design. In any event, even assuming *arguendo* that one of skill would look to modify the teachings of Emigh with the teachings of Juengst, the combined teachings still fail to disclose or suggest each and every limitation of the present claims.

More particularly, the Examiner acknowledges that Emigh fails to disclose, among many other claim limitations, "closing the gripping jaw, wherein at least one of the inserts is grasped between the first opposing member and the second opposing member, and wherein a distance from the upper portion to the lower portion of the bar at the extensible joint is proportion to the thickness of the at least one of the inserts." *Office Action mailed September 30, 2005*, pages 2-3. However, in support of the rejection, the Examiner asserts that Juengst discloses a gripping jaw including a first opposing member (7), a second opposing member (6), a bar (11) coupled to at least the first opposing member, wherein the bar comprising an upper portion and a lower portion, and wherein the upper portion is coupled to the lower portion via an extensible joint (44). The Examiner further asserts that Juengst discloses that at least one of the

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inserts is grasped between the first opposing member and the second opposing member, and that a distance from the upper portion to the lower portion of the bar at the extensible joint is proportional to the thickness of at least one of the inserts (Fig. 4). The Examiner then alleges that it would have been obvious to combine these teachings of Juengst with the teachings of Emigh to arrive at the present invention. Applicants respectfully traverse.

Whatever else Juengst may disclose, even assuming that one of skill would look to modify the apparatus of Emigh with the teachings of Juengst, the combined teachings still fail to disclose significant limitations of the present claims. Even when combined, the references fail to disclose or suggest, at a minimum, a method wherein upon closing the gripping jaw and grasping at least one insert between the first opposing member and the second opposing member of the gripping jaw, the extensible joint adjusts itself to vary a distance between the upper portion and the lower portion of the bar. Further, the references fail to teach or suggest that the adjustment of the extensible joint varies the distance from the upper portion to the lower portion of the bar such that the distance at the extensible joint is proportional to the thickness of the insert(s).

In this regard, the alleged extensible joint (44) of Juengst is not capable of adjusting itself to vary a distance between the upper portion and the lower portion of the bar as the gripping jaw closes. In the apparatus of Juengst, the alleged extensible joint (44) maintains a fixed orientation as the gripping jaw closes, and the upper portion and the lower portion of the alleged bar (11) maintains a fixed distance as the gripping jaw closes. Further, the "distance" between the upper portion and the lower portion of the bar (11) will not vary to be proportional to the thickness of insert(s) based on the adjustment of the extensible joint (44). Absent a teaching or suggestion, either in the references themselves or the knowledge of those skilled in the art, to modify the teachings of Juengst and Emigh to arrive at the present methods, it is submitted that the cited references do not render the claimed invention obvious.

For at least these reasons, withdrawal of this rejection is respectfully requested.

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Claim Rejections Under 35 U.S.C. § 103(a)

Claims 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Emigh and Juengst, and further in view of U.S. Patent No. 4,462,585 to Gieson et al. (hereinafter "Gieson"). This rejection is respectfully traversed for at least the reasons which follow.

Again, the present claims are directed to a method for selecting inserts for insertion wherein, upon closing the gripping jaw and grasping at least one insert between the first opposing member and the second opposing member of the gripping jaw, the extensible joint adjusts itself to vary a distance between the upper portion and the lower portion of the bar as the gripping jaw closes. This adjustment of the extensible joint varies the distance from the upper portion to the lower portion of the bar such that the distance at the extensible joint is proportional to the thickness of the insert(s).

Whatever else Gieson may disclose, it does not disclose an extensible joint that adjusts itself to vary a distance between the upper portion and the lower portion of the bar as the gripping jaw closes. Further, Gieson does not disclose that the extensible joint varies the distance from the upper portion to the lower portion of the bar such that the distance at the extensible joint is proportional to the thickness of the insert(s). As such, Gieson does not remedy the deficiencies of Emigh and Juengst as discussed above. As such, for at least those reasons, this rejection is likewise traversed, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

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If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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Date: December 29, 2005

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